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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1942

No. 515

F. A. SMITH MANUFACTURING CO., INC.,
Petitioner,

vs.

SAMSON-UNITED CORPORATION.

**PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE SECOND CIRCUIT AND BRIEF IN SUP-
PORT THEREOF.**

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PETITION FOR WRIT OF CERTIORARI.

*To the Honorable the Chief Justice and Associate Justices
of the Supreme Court of the United States:*

Your petitioner, F. A. Smith Manufacturing Co. Inc., prays that a writ of certiorari should issue to review the judgment of the United States Circuit Court of Appeals for the Second Circuit, entered August 28, 1942 (R. 535).

A certified transcript of the record in the case, including the proceedings in the Circuit Court of Appeals, is furnished herewith, in accordance with the Rules of this Court.

Summary Statement of the Matters Involved.

This action was brought in the United States District Court for the Western District of New York, before Harold

P. Burke, Judge, by the Samson-United Corporation vs. F. A. Smith Manufacturing Company, Inc., for infringement of claims 1 to 7 inclusive and claims 15 and 18 of patent No. 2,095,223 (R. 318), granted October 5, 1937, in the name of Abe O. Samuels, Assignor, to Samson-United Corporation, for a "fan". The Samuels patent in suit discloses a fan comprising, (a) a base or supporting bracket, (b) an electric motor mounted on the base or supporting bracket and (c) a fan blade assembly fixed to the shaft of the electric motor and rotated thereby.

The fan blade assembly comprises a bullet shaped metal hub or nosepiece provided with four equally spaced arcuate slots. Through each slot projects a rubber fan blade. The same blade being retained in the slots against centrifugal action, when the motor is operated, by shoulders formed along the base edges of the blade, which shoulders engage with the inner surface of the hub.

Each fan blade is formed or molded flat and when a fan blade is inserted into a slot of the hub, the blade is *conformed* by the engagement of the rubber blade with the slot in the hub, so that the *blade assumes a curved or cup shape*.

Prior to the present suit the Samuels patent had been considered and held valid and infringed by the Circuit Court of Appeals for the Second Circuit upon two occasions.

In the first case, namely, *Samson-United Corporation v. Sears-Roebuck Company*, 103 F. (2d) 312, the Court in considering this patent made the following statements:

"That it was not new to use rubber, as well as other pliable materials for making fan blades, is shown by the British Patent No. 3,203 granted to Siemens Brothers & Co., Ltd., in 1899."

"While the mere use of rubber in making fan blades was no 'invention', the use of a flexible material, which might of course be rubber, in the way the patentee taught how to use it to obtain the desired results by

attaching it in his way to the hub to increase its utility as a fan blade without destroying in any appreciable way its inherent safety qualities, was what the patent law is designed to protect."

"These desirable features were obtained by using flexible blades which, when cupped by insertion into arcuate grooves in the hub, were of sufficient rigidity to withstand the axial thrust required for rotation against air * * *.

Another important feature of construction was a rib at the base of each blade which extended outwardly from the plane of the blade on each side to overlap the inner edges of the sides of the slots in the hollow hub into which the blades were inserted so as to hold the blades immovable by centrifugal force when the fan was in motion."

In the second case, namely, *Samson-United Corporation v. Emanuel, et al.*, 109 F. (2d) 922, the Court said:

"The patent specifications were drawn to an electric fan like those then in common use with the exception of the blades which were made of rubber or other resilient material so cupped by having their bases inserted in arcuate slots in the fan hub that they were given sufficient ability to displace air satisfactorily * * *. * * *. These desirable features were imparted to the fan blades by the manner in which they were attached to the hub."

"We were careful to place the emphasis before, not on the use of rubber or any other resilient material for fan blades, but on the way such blades were attached to the hub to give them their new and desirable characteristics."

THE PETITIONER'S (DEFENDANT) ACCUSED FAN STRUCTURE.

The accused structure which is held to infringe the patent in suit, comprises a fan blade assembly in which the hub and blades are made entirely of rubber and cast or molded in one piece, by one molding operation, in which

each fan blade is given the desired shape and is integrally formed with the rubber hub.

THE DEFENSES ADVANCED BY PETITIONER WERE AS FOLLOWS:

1. The accused construction is generically different, particularly in the mode and manner of the association of the rubber fan blades and rubber hub than the construction disclosed in the Samuels patent and do not infringe the claims of that patent, particularly in view of the prior decisions of the Circuit Court of Appeals for the Second Circuit involving the Samuels patent wherein the scope of the said patent was clearly set forth.

2. The Samuels patent is invalid in view of Carlson patent No. 1370284 (R. 458), and Read Patent No. 4391 (R. 468), or in the alternative must be held to be so limited thereby that the distinctive construction of the accused structure could not properly be held to be an infringement thereof.

3. The Samuels patent in suit is invalid because Abe O. Samuels was not the originator or inventor of the fan structure disclosed in the Samuels patent. The subject matter of the patent in suit having been originated by one Marion W. Humphreys and disclosed to Abe O. Samuels who, after such disclosure and unbeknown to Humphreys, filed the application for patent which eventuated in the patent here in suit.

4. The Samuels patent in suit is invalid because in developing the fan blade assembly of the patent in suit, a commercial fan known as the "Gilbert fan" was used as the basis for the development of the patented fan and the originator merely substituted for the metal blade of the "Gilbert fan" a rubber blade which was essentially copied as to size and cup shape from the Gilbert fan, and the method

of attachment of the rubber blades of the patented fan employed the method of attachment used in a similar structure in the commercial "Deal" fan which was also used in connection with the development of the patented fan.

THE DISTRICT COURT.

The District Court found the Samuels patent valid and infringed (R. 502).

In connection with the defense that Samuels was not the original and first inventor but that Marion W. Humphreys originated and disclosed to Samuels the fan structure which is disclosed in the patent in suit, the District Court said:

"Up to the time of the present suit Humphreys has never asserted to Samuels or to the plaintiff any claim that he was the inventor."

His failure to assert against either the plaintiff or Samuels any claim of ownership of the invention or to voice any objection against Samuels claim of ownership until the present suit, is strong evidence that Humphreys was not the inventor and that he never believed himself to be the inventor.

"Under the circumstances as disclosed in this case the evidence tending to show that Humphreys was the first inventor cannot prevail."

The Court cited the case of *Holley-Hill Citrus Growers Association v. Holley-Hill Fruit Products*, 75 F. (2d) 13-17, in which case the Court invoked the doctrine of what it called evidentiary estoppel.

THE COURT OF APPEALS.

The judgment of the District Court was affirmed by the Circuit Court of Appeals, Second Circuit, on August 28, 1942, (R. 535). The decision was by divided court. Judge

Chase writing the opinion for the majority (R. 518) and Judge Frank dissenting with opinion (R. 522).

In the opinion of the Circuit Court of Appeals, the Court, in connection with its sustaining the judgment of the lower Court with respect to the defense urged below that Samuels was not the original and first inventor of the subject matter of the patent in suit, but that Humphreys was the originator said, "The District Judge who had the benefit of observing the witnesses, concluded that Humphreys claim to the invention was not to be believed." In this statement the writer of the opinion for the majority of the Court of Appeals fell into error in stating that the District Judge had the benefit of "observing the witnesses". The fact of the matter is that the witnesses who testified concerning these matters, did not appear in open court but the testimony was taken entirely by deposition as clearly pointed out by Judge Frank in his dissenting opinion. Furthermore, we would point out that the conclusion of the District Judge with respect to the testimony concerning the Humphrey claim of originality, was not primarily based upon any disbelief of the testimony given by the witnesses, but rather because of the failure of Humphrey to sooner assert his claim as to originality of the fan disclosed in the patent in suit, "the evidence tending to show that Humphreys was the first inventor cannot prevail." The District Judge was invoking against the Humphreys claim a species of estoppel.

Questions Presented.

1. Where an alleged inventor has actually studied and had before him a commercially established electric fan in which the fan blade assembly comprises a metal hub with curved or cupped metal blades attached thereto and from that situation produces a fan blade assembly in which the

blades are essentially copied as to size and cup shape except that they are made of rubber instead of metal and where admittedly rubber bladed fans generally were known in the prior art, did it involve invention to make such substitution of rubber blades for metal blades?

2. Where an alleged inventor has actually before him a commercial fan in which the fan blade assembly comprises a metal hub with curved or cupped metal blades attached thereto and also has before him an established commercial fan in which the air propelling elements were of flexible material but of different shape and make-up than those customarily employed with metal bladed fans but where such air propelling elements were secured to the rigid hub by means of a slot in the hub and a cooperating shoulder on the air propelling elements and from that situation produces a fan blade assembly in which the blades are essentially copied as to the size and blade shape of the commercial metal bladed fan except that the blades are made of rubber and where such rubber blades are secured to the hub by means of a slot in the hub and a shoulder on the blade and where admittedly rubber bladed fans generically were known in the prior art, did it involve invention to make such substitution of rubber blades for metal blades and secure the rubber blades to a rigid hub by a construction involving slots in the hub and shoulders on the rubber blades?

3. Where the prior art shows that it was old and known to make a fan blade assembly by casting as an integral structure the hub and fan blades and where the fan blades are curved and cup shaped, did it involve invention to cast as an integral structure in rubber, a similar hub with similar curved fan blades?

4. Whether or not a fan having a blade assembly comprising a hub and curved blades integrally cast or molded

in rubber infringes a patent disclosing a fan having a blade assembly comprising individual rubber blades projecting outwardly through curved slots in a metal nose-piece or hub and wherein the individual rubber blades are initially molded flat and when assembled in the slots of the hub are thereby conformed to a curved or cup shape.

5. Whether or not a fan having a blade assembly comprising a hub and curved blades integrally cast in rubber, infringes a patent disclosing a construction and characteristics set forth in the preceding question and wherein the blade assembly of the accused fan is essentially identical in appearance and construction with a prior art fan blade assembly except for the fact that the blade assembly of the accused fan is made of rubber whereas the prior art blade assembly was made of metal and these fan blade assemblies made of rubber were generically known in the art.

6. Is it error on the part of a court, in refusing to give full faith and credit to the testimony of a witness, whose testimony is corroborated, as to the fact that such witnesses originated the alleged invention claimed in a patent in suit, on the ground or because of the fact that the witness in question had not at any time prior to the suit in which he testified advanced his claim and contention as to origin of the alleged invention, although he knew that the alleged inventor had filed an application for patent (in suit) shortly after such filing had been made, where the witness claiming to be the originator is not a party to the suit but was called as a witness by the defendant, who represents the public, thus essentially invoking an estoppel which is against the public interest.

Reasons Relied Upon for the Granting of the Writ.

The discretionary power of this Court to grant a writ of certiorari is invoked upon the following reasons:

1. That the decision of the Court of Appeals of the Second Circuit in holding the petitioner's accused rubber fan blade assembly as an infringement of the patent in suit, has enlarged the invention, (if any), beyond that disclosed by the patent itself. This being clearly in derogation of the fundamental holding of the Supreme Court in the case of *Schriber-Schroth Co., v. Cleveland Trust Company*, 305 U. S. 47-57.

2. That the Circuit Court of Appeals for the Second Circuit has sustained as valid a patent and has construed the claims of such patent so broadly that the patent dominates the entire market for curved rubber bladed fans and due to the size and importance of the market embraced within the Second Judicial Circuit, it is exceedingly difficult, if not impossible, as a practical proposition, for the rubber bladed fan industry to operate within this market. Respondent can thus maintain, practically speaking, entire domination of the rubber bladed fan industry without bringing suits outside of the Second Circuit. Thus it is improbable that a conflicting decision will occur in another Circuit.

3. That the decision of the Court of Appeals in this case, is in apparent conflict with the decisions of the Supreme Court in *Cuno Corporation v. Automatic Devices*, 314 U. S. 48; *Altoona Publix Theaters Inc. v. American Tri-Ergon Corporation*, 294 U. S. 477, and *Florsheim v. Schilling*, 137 U. S. 64, on the question of what constitutes invention.

4. That the Court of Appeals for the Second Circuit has erred in their failure to give full faith and credit to the evidence and testimony of witnesses produced to sustain the contention that the patentee was not the true and original inventor of the alleged invention in the patent in suit, on the ground that the alleged prior originator or inventor, (if it be an invention), had not sooner asserted his claim,

thus in effect precluding relief not only against the alleged infringer but also relief to the public from the asserted monopoly.

The action of the Court of Appeals is asserted to be in conflict with the pronouncement of this Court on similar subject matter in the case of *Paramount Publix Theaters Corp. v. American Tri-Ergon Corporation*, 294 U. S. 464, 477.

Wherefore, your petitioners respectfully pray that a writ of certiorari issue out of and under the seal of this Court directed to the United States Court of Appeals for the Second Judicial Circuit, commanding said Court to certify and send to this Court, on a date to be designated, a full transcript of the record and all proceedings of the Court of Appeals had in this cause, to the end that this case may be reviewed and determined by this Court, as to the questions herein presented and that the judgment of the Court of Appeals be reversed, and that petitioner may be granted such other and further relief as may seem proper.

F. A. SMITH MANUFACTURING Co., INC.,
By A. J. HUDSON,
JAMES T. HOFFMAN,
Counsel for Petitioner.

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1942

No. 515

F. A. SMITH MANUFACTURING CO., INC.,
Petitioner,

vs.

SAMSON-UNITED CORPORATION.

**BRIEF IN SUPPORT OF PETITION FOR WRIT OF
CERTIORARI.**

Opinions of the Courts Below.

The opinion of the United States District Court for the Western District of New York, which is not reported, appears at page 489 of the record. The opinion of the Circuit Court of Appeals for the Second Circuit appears at page 518 of the record and is reported in 130 F. (2d) 525.

Jurisdiction.

1. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended by the Act of February 13, 1925 (28 U. S. C. Sec. 347).

2. The date of the judgment of the Circuit Court of Appeals for the Second Circuit, which petitioners seek to have reviewed, is August 28, 1942 (R. 535).

Statement of the Case.

The essential facts of the case are stated in the accompanying petition for writ of certiorari.

Specification of Errors.

The errors which petitioner will urge if the writ of certiorari is issued are that the Circuit Court of Appeals for the Second Circuit erred:

1. In holding the claims in issue of Samuels Patent No. 2,095,223 valid and infringed.
2. In failing to hold the claims in issue of Samuels Patent No. 2,095,223 invalid.
3. In failing to hold the claims in issue of Samuels Patent No. 2,095,223 not infringed.
4. In failing to hold that the alleged invention of Samuels Patent No. 2,095,223 did not require the exercise of inventive ingenuity but merely mechanical skill and, therefore, invalid as lacking in invention.
5. In failing to hold that the alleged invention of Samuels Patent No. 2,095,223 involved merely a substitution of material and that the patent was, therefore, invalid as lacking in invention.
6. In failing to hold that A. O. Samuels was not the original and first inventor of the subject matter of Samuels Patent No. 2,095,223.

Summary of Argument.

THE POINTS OF ARGUMENT WILL FOLLOW THE REASONS RELIED
UPON FOR ALLOWANCE OF THE WRIT OF CERTIORARI.

ARGUMENT.

1. The decision of the Court of Appeals of the Second Circuit in holding the petitioner's accused rubber fan blade assembly an infringement of the patent in suit, has enlarged the invention (if any) of the patent in suit beyond that disclosed by the patent itself. This being clearly in derogation of the fundamental holding of this Court in the case of *Schriber-Schroth Co. v. Cleveland Trust Company*, 305 U. S. 47-57.

The accused structure which is held to infringe comprises a fan blade assembly in which the hub and blades are all made of rubber and cast or molded in one piece by one molding operation so that each fan blade is given the desired curved or cupped shape and is integrally formed with the rubber hub (Deft's Ex. 76).

If a rubber blade of the accused fan assembly be severed along the juncture of the blade with the hub, the blade retains its curved shape (R. 501).

The fan blade assembly of the patent in suit is a composite structure. The hub or nosepiece is made of metal in which are formed curved slots. The fan blades are made of rubber and have shoulders formed on both sides adjacent their lower edge.

As pointed out in the specification of the Samuels Patent:

"The blades are made substantially flat and uniform in cross section" (R. 321, Col. 2, Line 48).

When the blades are assembled with respect to the hub, they are retained in the slots by the engagement of the

shoulders on the blades against the inside of the hub and in addition, and this is very important, *the slots in the hub cause the fan blade to be conformed to a cupped shape.*

As pointed out in the Samuels specification,

“The slots 2, 2 in the casing thus hold each fan blade against endwise and outward movement on the casing and at the same time hold the bases of the blades curved or cupped” (R. 322, Col. 1, Line 10).

It is now pointed out that in the Samuels specification and drawing, no other means or expedient is described or even hinted at for attaching to the hub and cupping the fan blades, except the expedient of arcuate slots in the hub and rubber blades formed with shoulders at their lower edge.

It is clear that the genius of construction of the accused integrally formed hub and blade assembly is distinctly different from that which is disclosed by the Samuels patent.

Second Circuit Court of Appeals.

PRIOR CONSIDERATION OF SAMUELS PATENT.

The Samuels patent, here in suit, has twice before been before the Court of Appeals. First, in the case of *Samson-United Corporation v. Sears, Roebuck & Company, Inc.*, 103 Fed. (2d) 312, and later in the case of *Samson-United Corporation v. Emanuel et al.*, 109 Fed. (2d) 922.

In the Sears-Roebuck case the Court made several statements concerning the invention disclosed in the Samuels patent, as follows:

“That it was not new to use rubber, as well as other pliable materials for making fan blades, is shown by the British Patent No. 3,203 granted to Siemens Brothers & Co. Ltd., in 1899.”

“While the mere use of rubber in making fan blades was no invention, the use of a flexible material, which

might of course be rubber, in the way the patentee taught how to use it to obtain the desired results by attaching it in his way to the hub to increase its utility as a fan blade without destroying in any appreciable way its inherent safety qualities, was what the patent law is designed to protect." (Italics ours.)

"These desirable features were obtained by using flexible blades which, when cupped by insertion into arcuate grooves in the hub, were of sufficient rigidity to withstand the axial thrust required for rotation against air * * *. Another important feature of construction was a rib at the base of each blade which extended outwardly from the plane of the blade on each side to overlap the inner edges of the sides of the slots in the hollow hub into which the blades were inserted," etc. (Italics ours.)

In the Emanuel case the Court remarked concerning the Samuels patent:

"The patent specifications were drawn to an electric fan like those then in common use with the exception of the blades which were made of rubber or other resilient material so cupped by having their bases inserted in arcuate slots in the fan hub that they were given sufficient ability to displace air satisfactorily," etc. (Italics ours.)

"We were careful to place the emphasis before, not on the use of rubber or any other resilient materials for fan blades, but on the way such blades were attached to the hub to give them their new and desirable characteristics."

"It is true that metal fan blades of the shape the blades of the patented fan assumed when put into the hub slots were old and so was the method of attaching them to the hub by tabs put into holes and twisted over. But when rubber blades were used it took more than a mere change of material from metal to rubber and needed what the patentee disclosed to make them satisfactory. He did it by embedding the rubber base

of the blade in the metal of the hub in a slot so shaped that pressure would deform the blade as desired."
(Italics ours.)

In both the Sears-Roebuck case and the Emanuel case, the accused structures were held to infringe. In both these cases the accused structures were two-part structures, that is to say, the metal hub and fan blades were independently made. Mechanical instrumentalities were used to fasten the fan blades upon the hubs, which instrumentalities served not only to fasten the blade to the hub but also to conform the rubber blade to assume a dished shape.

In the Sears-Roebuck case the Court said concerning the accused structure:

"The hub is made in two pieces with arcuate slots when the separate parts are joined and with depressions into which the buttons on the blades fit. When the blank of blades is placed in proper position between the two parts of the hub and those parts are joined together the assembled fan is equipped with blades of flexible material so curved by the distortion of the bases in the arcuate slots of the hub and held there against centrifugal force by the embedded buttons that a fan having the peculiar characteristics of the patented fan is the result."

In the Emanuel case the Court said concerning the accused structure:

"He (Samuels) did it by embedding the rubber base of the blade in the metal of the hub in a slot so shaped that pressure would deform the blade as desired. The defendant has done it by embedding a piece of metal, later to be made virtually a part of the hub, in the rubber base of the blade. To put metal into the rubber instead of the rubber into the metal is not enough to avoid infringement." (Above parenthesis added.)

Judge Frank, in his dissenting opinion in the instant case, stated:

"In the earlier cases, this court in sustaining validity, did so, on the narrow basis of the patentee's use of 'slots'; and there are no 'slots' in the alleged infringing device here."

"Some (not all) of these factors are recognized in the majority opinion. In effect, that opinion says that our prior decisions sustaining this patent are of little relevance here; and it sustains the patentee's validity and finds infringement on the basis that Samuels invented a fan with a distinctive shape given to the rubber blades. The majority concedes that there was no invention in rubber blades. The pivotal factor in the majority opinion is the shape of Samuels' blades. Yet the majority also, to some extent, recognizes—although it does not highlight that fact—that the shape of the blades was copied by Samuels from the Gilbert metal-bladed fan."

The patent showing the Gilbert fan is found at page 370, of the Record, and a commercial embodiment of the Gilbert fan was introduced in evidence as defendant's Exhibit 75.

The majority opinion of the Second Circuit Court of Appeals states, on this subject, the following:

"The several prior art patents which were not considered in our previous opinions which are now relied on will be discussed following a restatement of the scope of the patent to dissipate any idea that it is limited to the mere method of the attachment of demountable fan blades to the hub or that the avoidance of that feature is a by-pass of the entire patent."

"What Samuels did show, however, was a conformation which was a means of attaining sufficient rigidity in the blades so that they would keep their shape and utility; look like fan blades when the fan was not in operation—an important selling feature—while at the same time the requisite softness was preserved to prevent damage to a solid object coming into contact with the revolving blades themselves."

Very clearly, therefore, the Court of Appeals for the Second Circuit has by its majority opinion enlarged the scope of the Samuels patent over what it had before considered such scope to be in its prior decisions.

In effect, the opinion of the Court of Appeals gives Samuels a patent on a flexible blade having a "conformation" which provides its shape and at the same time preserves its flexibility and prevents damage if the blade, during its rotation contacts with a solid object.

This very safety feature, in a different shape of fan blade, is clearly disclosed in French Patent No. 375,817 (R. 478 and 481).

A perusal of the specification and drawings of the Samuels patent in suit clearly shows that the scope now given to that patent by the Court of Appeals of the Second Circuit transcends the disclosure of the patent itself. The Samuels patent discloses a fan in which the blades are individually formed and assembled upon a hub or nosepiece, by inserting the lower portions of the blades in arcuate slots and the provision of shoulders upon the lower edges of the blades which prevent the fan blades from flying out by centrifugal action during the rotation of the fan.

The blades are *conformed* to their cup shape by the curvature of the arcuate slots.

Granted that every patent is entitled to a range of equivalents, it is axiomatic that such range of equivalents must come within the scope of the disclosure of the patent itself.

The practical result flowing from the decision of the Court of Appeals, in the instant case, is that nobody can manufacture a curved rubber bladed fan without infringement of the Samuels patent regardless of whatever means or expedient may be employed to attain the curved shape of the blade.

Clearly this is too broad an interpretation of the Samuels patent and not justified by the disclosure of that patent.

This is particularly true in consideration of the fact that the prior art commercial Gilbert fan discloses a blade which has a shape and curvature almost precisely the same as that of the fan blade shown in the Samuels patent.

And further, as will be subsequently pointed out, the origin and development of the shape and form of the fan blade of the Samuels patent was predicated upon and copied from the commercial Gilbert fan.

2. That the Circuit Court of Appeals for the Second Circuit has sustained as valid a patent and has construed the claims of such patent so broadly that the patent dominates the entire market for curved rubber bladed fans and due to the size and importance of the market embraced within the Second Judicial Circuit, it is exceedingly difficult, if not impossible, as a practical proposition, for the rubber bladed fan industry to operate within this market. Respondent can thus maintain, practically speaking, entire domination of the rubber bladed fan industry without bringing suits outside of the Second Circuit. Thus it is improbable that a conflicting decision will occur in another circuit.

From the point of view of the fan industry, the manufacture and sale of rubber bladed fans is materially stifled, if not prevented, due to the fact that the area comprised by the Second Judicial Circuit is so extensive and controlling with respect to the retail sale of rubber bladed fans that a manufacturer deprived of an opportunity to sell within the territory embraced in the Second Circuit, would find himself in a commercially impossible situation.

3. The decision of the Court of Appeals for the Second Circuit in this case, is in apparent conflict with the decisions of the Supreme Court in Cuno Corporation v. Automatic Devices, 314 U. S. 48; Altoona Publix Theaters Inc., v. American Tri-Ergon Corporation, 294 U. S. 477; and Florsheim v. Schilling, 137 U. S. 64, on the question of what

constitutes invention. There is no controversy but that the following statement of fact is clearly established.

In 1935 the Samson-United Corporation was engaged in the manufacture of electric goods such as toasters, waffle irons and kindred devices employing the principle of electric heating.

Abe O. Samuels, the patentee of the patent in suit, was actively associated with that Company as its President.

One Marion W. Humphreys was employed as an engineer by the K-W Ignition Company of Cleveland, Ohio, which Company was seeking outlet for an electrical motor suitable for food mixers, fans, etc., which they were prepared to manufacture. Humphreys was acquainted with Samuels and through certain correspondence Humphreys learned that the Samson-United Corporation contemplated increasing their line to include electric fans of the type suitable for home and office use. As a result of this correspondence Humphrey, together with Albert S. Hanson an official of the K-W Ignition Corporation, called upon the Samson-United Corporation at their plant in Rochester, New York, upon the 15th day of August, 1935. There they met Mr. Samuels and other persons connected with the organization of the Samson-United Corporation for the purpose of discussing the matter of the possibility of the K-W Ignition Corporation selling to the Samson-United Corporation electric motors for use in the electric fan which was in contemplation by the Samson-United Corporation.

At the time of this conference and during the conference, there was considered by the parties present a metal fan then on the market known as the Gilbert fan (Defendant's Ex. 75), and also a fan then on the market known as the Deal fan (Defendant's Ex. 60).

Samuels stated that he wanted a fan which would do away with the use of a guard, customarily used with metal bladed fans, to protect against injury by the accidental

thrust of the hand of a person, into the path of the rotating metal blades.

The commercial Gilbert fan which they had before them was a metal bladed fan and required the use of a fan blade guard.

The Deal fan, on the other hand, employed loops of fabric as the air moving elements and since these elements were not metallic, they would not injure the hand of a person who might accidentally thrust his hand into the path of the air producing elements of the fan and therefore the fan elements required no guard.

Samuels' objection to the Deal fan was that the blades were "too floppy" and were not satisfactory because it did not look like a fan.

According to the testimony of Samuels, he, Samuels, wanted Humphreys to take the Gilbert fan and reproduce the blades in rubber and fasten them to the hub by "appropriate screws, rivets or the like."

There is some conflict of testimony between Humphrey (who is supported by the testimony of Hanson), and the testimony of Samuels as to who first suggested the use of rubber blades for the fan. But beyond that there is no question but that as a result of the general discussion of the Deal fan, the Gilbert fan, and the matter of rubber blades, that Humphreys agreed to endeavor to produce a rubber bladed fan, taking the Gilbert fan as a basis and substituting for the metal blades of the Gilbert fan, rubber blades of essentially the same shape and curvature.

Humphreys did produce such a fan having rubber blades which were curved and were of essentially the same size and configuration as were the metal blades of the Gilbert fan, and the blades were assembled on the nosepiece or hub of the fan by means of arcuate slots and shoulders on the lower edges of the rubber blades in precisely the manner which is shown in the Samuels patent in suit. As a matter

of fact, the testimony shows that a model fan produced by Humphreys was used by Samuels as the basis of his patent application which eventuated in the patent in suit.

Thus we see that whether Samuels or Humphreys be credited as the originator or inventor of the rubber bladed fan of the patent in suit, the fact is that the fan of the patent in suit is precisely like the hub of the commercial Gilbert fan and the rubber blades were copied as to size and cup shape from the fan blades of the Gilbert patent.

It is contended that what was done, as set forth above, did not involve invention but only mechanical skill.

Rubber bladed fans were old in the art as is stated by the Court of Appeals for the Second Circuit in the Sears-Roebuck case and also in the Emanuel case. Therefore, to merely copy in rubber the blade of the commercial Gilbert fan, and secure such rubber blade to the metal hub, involved only mechanical skill and not invention.

In the case of *Cuno Corporation v. Automatic Devices* (supra), this Court stated:

“It has been recognized that if an improvement is to obtain the privileged position of a patent more ingenuity must be involved than the work of a mechanic skilled in the art.”

Humphreys was skilled in the art. The evidence clearly showed that he had been associated with companies in the manufacture of metal bladed fans and had even experimented with flexible bladed fans which were made out of rubberized fabric.

In the case of *Altoona Publix Theaters Inc. v. American Tri-Ergon Corporation* (supra), this Court said:

“The patentees brought together old elements, in a mechanism involving no new principle, to produce an old result, with greater uniformity of motion. However skillfully this was done, and even though there

was produced a machine of greater precision and a higher degree of motion constancy, and hence one more useful in the art, it was still the product of skill, not of invention.”

In the instant case, the originator of the specific fan assembly shown in the patent in suit merely borrowed from the prior art the use of rubber for a fan blade and utilized it in precisely the same manner, as to size and curvature, as that which had been established in the art by the commercial Gilbert fan.

Even the manner of attaching the rubber fan blades to the metal hub set forth in the patent in suit, is clearly suggested and pointed out in the commercial Deal fan where the flexible air producing elements are attached to the hub by means of slots in the hub and a shoulder on the flexible air producing member which cooperates with the slot in the hub to secure the ends of the air producing member against flying outwardly under centrifugal action when the fan is operated.

In another aspect, the fan construction set forth in the patent in suit involved merely the substitution of one material for another. Actually, in the development of the fan in suit a rubber blade of essentially the same size, shape and curvature was substituted for the metal blade of the commercial Gilbert fan.

This Court has said in the case of *Florsheim et al. v. Schilling* (supra),

“but the substitution of one material for another, which does not involve change of method, nor develop novelty of use, even though it may result in a superior article, is not necessarily a patentable invention.”

As before stated, the use of rubber for the blade of a fan was not new or novel at the time the patent in suit was applied for.

In addition to the foregoing we would point out that in the prior art there is a patent to one Carlson, granted in 1921 (R. 458), which discloses a fan blade assembly consisting of a hub and curved blades which were "cast as an integral structure." From the disclosure in the patent the fan blade assembly was cast in metal.

Could it be said to involve invention to cast in rubber, instead of metal, the fan blade assembly shown in the Carlson patent? We assert that the answer must be in the negative. And yet the Court of Appeals for the Second Circuit in holding the accused structure as an infringement of the Samuels patent has concluded that such a procedure would involve invention.

The prior art also contains the patent to Read, No. 4391, granted in 1871 (R. 468), in which there is shown a propeller which comprises a hub with radiating curved blades which are integrally cast in rubber, the patent stating,

"The vulcanized rubber, while very strong, is yet slightly elastic, so that if sprung out of form by any extraordinary force it will, when that pressure is removed, resume its original shape without breaking,"

The hub and blade construction of the Read patent while not directly in the art relating to air fans is, nevertheless, in an analogous art.

The prior art patent to Aulsing, No. 2023113 (R. 443), is interesting as disclosing an integral metal fan blade assembly made as a stamping, including a hub portion and radiating curved or cup shaped blades.

4. The Court of Appeals of the Second Circuit has erred in its failure to give full faith and credit to the evidence and testimony of witnesses produced to sustain the contention that the patentee was not the true and original inventor of the alleged invention in the patent in suit on the ground that the alleged prior originator or inventor (if it

be an invention) had not sooner asserted his claim, thus, in effect, precluding relief not only against the alleged infringer but also relief to the public from the asserted monopoly. This action of the Court of Appeals is asserted to be in conflict with the pronouncement of this Court on similar subject matter in the case of **Altoona Publix Theaters, Inc., v. American Tri-Ergon Corporation** (*supra*).

We have before pointed out the circumstances under which the alleged invention of the patent in suit was originated.

Shortly after Samuels filed his application for patent, which eventuated in the patent in suit, Humphreys became acquainted with the fact that Samuels had made such filing.

Humphreys did not at that time set forth any claim on his part that he was the originator and inventor of the subject matter of the rubber bladed fan in question and explains the situation by giving two reasons. First, he did not consider that the fan which he had developed was a patentable invention and second, inasmuch as his employer, the K-W Ignition Company, were seeking to obtain an order for motors and shortly thereafter did actually obtain an order for motors from the Samson-United Corporation for use with the fans in question, his employers advised against entering into any controversy with Mr. Samuels which might interfere with or injure their business relations with the Samson-United Corporation.

Humphreys therefore never asserted his own claim to being the originator or inventor (if there be an invention), with respect to the fan disclosed by the patent in suit, until after the institution of the suit by Samson-United Corporation against the petitioner.

The testimony of Humphreys and his corroborating witnesses was practically entirely taken by way of deposition and the majority opinion of the Court of Appeals is in error

in stating that the District Judge "had the benefit of observing the witnesses."

In the District Court, the Judge, in his opinion (R. 492), stated, as his reason for denying consideration of the testimony as to Humphreys' origination of the fan of the patent in suit, the following:

"His failure to assert against either the plaintiff or Samuels any claim of ownership of the invention or to voice any objection against Samuels' claimed ownership until the present suit is strong evidence that Humphreys was not the inventor and that he never believed himself to be the inventor. This evidence is not overcome by his now belated claim when circumstances have changed, when the patented fan has long since attained success on the market, when the plaintiff as owner of the patent has already borne the expense of three infringement suits to sustain its validity and to demonstrate infringement and when Humphreys is now employed by the manufacturer who supplies the defendant with hub and blade assembly for the accused fan. Under the circumstances as disclosed in this case *the evidence tending to show that Humphreys was the first inventor cannot prevail.*"

Evidently the District Judge was at least convinced that there was evidence "tending to show that Humphreys was the first inventor," but that for the reasons assigned, which seemingly was Humphreys' delay in asserting his origination of the subject matter of the patent in suit, the Court decided that such evidence "cannot prevail."

The Court cited the case of *Holley Hill Citrus Growers' Association et al. v. Holley Hill Fruit Products, Inc.*, 75 Fed. (2d) 13-17, as "singularly apropos." This case states as follows:

"There is a kind of evidential estoppel which, though it may not amount to a complete estoppel in pais, is raised when persons who have spoken or acted one

way under one set of circumstances, and with one objective in mind, undertake under other circumstances and when their objective has changed, to testimonially give a different color to what they formerly said and did."

It will thus be seen that clearly in the mind of the District Judge, he was invoking a species of estoppel against Humphreys.

In the instant case Humphreys is not a party to the suit. He and other witnesses who support his testimony were called to give testimony on behalf of the defendant.

The instant case is not one wherein Humphreys is seeking to recapture and claim for himself an invention which he had "let slide."

Moreover, it should be noted that the Court's remark concerning the fact that the plaintiff has already borne the expense of three infringement suits, has no pertinency in the instant case since there is absolutely no testimony that Humphreys had anything to do with these cases or even knew that they had been filed or tried.

Your petitioner (defendant), and the general public whom he represents, have a very real interest in whether the Samuels patent is a valid patent and, therefore, it was improper for the District Court to, in effect, invoke the doctrine of estoppel with respect to the testimony of Humphreys and his corroborating witnesses, because to do so was directly against public interest.

In the case of *Paramount Publix Corporation v. American Tri-Ergon Corporation*, 294 U. S. 464-477, the Supreme Court considered a situation which was similar in principle though differing in detail to that which is involved in the instant case. In the Paramount case, the lower Court had decided that the petitioner was estopped to deny the validity of the patent there involved in suit because petitioner, or one standing in privity with him, had filed an applica-

tion in the Patent Office for the subject matter as the patent in suit, which had been rejected by the Patent Office.

This Court said:

“However inconsistent this early attempt to procure a patent may be with petitioner’s present contention of its invalidity for want of invention, this Court has long recognized that such inconsistency affords no basis for an estoppel nor precludes the Court from relieving the alleged infringer and the public from the asserted monopoly when there is no invention.”

In the case of *Lorenz et al. v. Colgate-Palmolive-Peet Company*, 122 Fed. (2d) 875-880, the Circuit Court of Appeals for the Third Circuit had under consideration a case which involved an action under 4918 of the revised statutes.

In that case the defendant in the lower court had urged invalidity of the patent and the plaintiff contended that the defendant was estopped from denying the validity of the plaintiff’s patent because the defendant was the owner of an interfering patent and also there had been an interference proceeding in the Patent Office which had involved the question of originality.

The Court said:

“Any possible estoppel of parties would be without relation to the court’s power to declare a patent invalid upon sufficient showing or its duty to exercise such power in an appropriate case. * * * In any event, it would seem that, in a suit involving patent validity, the operation of the doctrine of estoppel could extend no further than to the private rights of the interested parties inter se, and certainly not to the right of (patent) monopoly in which the public has an interest. * * * Over and above the defendant’s private rights or lack of them, the defenses here alleged are material to the question of the Lorenz patent’s validity which is directly in issue under the plaintiff’s bill of complaint.”

The Court of Appeals for the Second Circuit by their opinion have, in effect, upheld the action of the District Judge in applying what amounts to an estoppel with respect to the testimony of Humphreys and his corroborating witnesses.

In connection with the foregoing discussion, we would invite this Court's attention to the dissenting opinion of Judge Frank, and particularly that portion of his opinion which relates to the Humphreys testimony (R. 533).

Respectfully submitted,

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Counsel for Petitioner.

FILED

DEC 4 1942

CHARLES ELMORE COOLEY

Supreme Court of the United States

OCTOBER TERM, 1942.

No. 515

F. A. SMITH MANUFACTURING CO., INC.,
Petitioner,

vs.

SAMSON-UNITED CORPORATION,
Respondent.

**BRIEF FOR RESPONDENT IN OPPOSITION
TO PETITION FOR CERTIORARI**

W. B. MORTON,
Counsel for Respondent.

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The decision sought to be reviewed by this petition is the third decision of the Circuit Court of Appeals for the Second Circuit sustaining the patent in suit as valid and infringed. The three appeals were from three different districts in the same Circuit and each of the District Judges also held the patent in suit to be valid. In the two earlier cases the District Judges held the patent not infringed by the particular fans there in issue but in each instance were reversed by the Court of Appeals which specifically held the patent to cover a meritorious invention and to be entitled to reasonably broad construction.*

In the case at bar the District Court also held the patent infringed and the Court of Appeals in affirming that deci-

*Samson-United Corp. vs. Emanuel et al, 109 F. (2d) 922, 923.

sion held: "The accused fan is to all intents and purposes a copy of the assembled patented fan" (R. II, 522). They then went on to say: "There is no difference at all in the fans patentwise. * * * Merely to mold in one piece what the patentee elected to assemble from more than one was but to substitute an obvious equivalent for what the specifications disclosed" (R. II, 522).

There would seem to be no such conflict in the decisions of the lower courts as to require a review by this Court of the decision in the case at bar.

The Questions Presented

The questions presented by this case are the usual questions presented by every patent case:

- (1) The novelty and utility of the patented structure over the prior art.
- (2) Whether the accused structure presents such departures from the specific structure of the patent as to be without the scope of the patent.

The statement of "the questions presented" by the petitioner (Petition pp. 6-8) makes it plain that, aside from an alleged question of evidence (Question 6), the case presents nothing more than this necessary comparison of the prior art structure, the patented structure and the accused structure. Question 6 (Petition, p. 8) purports to find a question of estoppel presented by the comment of the court in its opinion on the inconsistency between the actions of a pleaded prior inventor at the time of his alleged invention and his claim of inventorship made for the first time in this suit. It is obvious from the opinion that no question of estoppel is presented. The Court merely, as it said, took into consideration the conduct of the witness in weighing his testimony and decided that the allegation of prior inventorship was not proven.

Reasons Relied Upon for the Granting of the Writ

The alleged reasons for granting the writ find no basis in the facts presented by the record.

1. The opinion of the Court of Appeals presents no conflict with the opinion of this Court in *Schriber-Schroth Co. vs. Cleveland Trust Co.*, 305 U. S. 47-57. In that case this Court held the patent in suit had been broadened by amendment, unlawfully added. No such question is presented here. In fact no transcript of the Patent Office proceedings in the application for the patent here in suit is included in the record. The Court of Appeals in the case at bar specifically found "no difference at all * * * patent-wise" between the fan of the patent and the accused fan (R. II, 522). It requires no "enlargement" of a patent to hold it infringed by a substantially identical structure.

2. There is no foundation for petitioner's contention that the fan industry is in any way limited to the Second Circuit. In the *Tri-Ergon* case this Court granted certiorari on a showing that practically the entire motion picture industry was subject to the jurisdiction of the New York courts, and in *Schriber-Schroth Company vs. Cleveland Trust Co. supra*, this Court took judicial notice of the fact that the automobile industry is largely centered in the Sixth Circuit.

The Court may very well take judicial notice of the fact that there is no such centralization of the fan industry. The particular infringer in the case at bar happens to be located in the same city as plaintiff—Rochester, N. Y., but there is no centralization of fan manufacture in that city. In fact all the larger manufacturers of fans are located elsewhere, for the most part in different circuits.

3. There is no conflict between the decision of the Court of Appeals in the case at bar with the decisions of this Court in *Cuno Corp. vs. Automatic Devices Corp.*, 314 U. S. 84; *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corporation*, 294 U. S. 477, and *Florsheim v. Schilling*, 137 U. S. 64.

In the *Cuno* case, this Court held that the addition to an old electric cigar lighter of a thermostatic switch previously used for the same purpose in electric heaters, toasters and irons, was not invention (314 U. S. 84, 91).

In the *Tri-Ergon* case "no invention" was found in the addition to an old driving gear arrangement of a flywheel for its recognized purpose of maintaining uniform motion.

In the *Florsheim* case, the decision of the Court is summarized in the following paragraph:

"In the light of the authorities, our judgment is that the appellants' patent No. 238,100 was for a corset that had been in long and publicly known use, each part of it previously patented; that it involved nothing original in the construction of those parts nor in their relation to one another, nor any change in the function of any one of them; and that the combination of them produced no original mechanism or device."

The Court of Appeals of the Second Circuit in its second decision dealing with the patent here in suit, *Samson-United Corporation v. Emanuel*, 109 F. (2d) 922, 923, thus summarized the patentee's accomplishment:

"What he [the patentee] did was to take a well-known type of fan; make its blades of a well-known material; shape them as metal had been shaped for fan blades and in doing so preserved a sufficient amount of the natural pliability of the material to keep the blades practically harmless in operation while adding sufficient stiffness to them to make them effi-

cient in use. Though the change from the old was structurally slight, it was great in terms of accomplishment.”*

4. As we have pointed out above, there is no question of estoppel presented by this case. The situation is merely the familiar one where courts have properly given weight to the former words and deeds of the witness at the time of the event, which are inconsistent with his present contentions. The mechanic Humphreys who now comes forward with a claim of inventorship, and his immediate employers, the K-W Ignition Corp., fully recognized at the time they were making the experimental models of the patented fan that the invention they were engaged to develop was that of Samuels. In answer to a letter (R. II, 340, 341) written by Samuels to the K-W Ignition Corp. while this work was going on (Deft's. Exh. 11, R. II, 340) wherein he requested that the development with respect to “my invention” be kept “strictly confidential,” (this was before the application for patent was filed), that company, by its Vice President who had charge of the matter, replied (R. II, 342):

“Also please rest assured that any idea which you may talk over with us or which we may assist in developing will be treated with exactly as much confidence, if not more so, as though you were doing it in your own plant as, of course, we feel an obligation to merit the confidence placed in us by our customers as though it were something of our own that we were bringing out for our own distribution.”

The Court of Appeals very properly held that the present totally inconsistent claim of Humphreys to be the original inventor had to be established by evidence of more weight than anything presented in this record.

*The Gilbert fan patent, on which the petitioner mainly relies, was also the principal reliance of the defendant in the Emanuel case (R. II, 522, last sentence).

The petitioner concludes its argument with the request that this Court give careful consideration to the dissenting opinion of Judge Frank. Judge Frank was appointed to the Court after the decisions were rendered in the first two cases involving the patent in suit. Since he had not seen the records in those cases, which are not in evidence here, he apparently reviewed the records before writing his dissenting opinion. He found what he felt was an inconsistency between the testimony of the patentee in the former cases and the present case. Judge Frank overlooked the fact that in the earlier cases no claim of prior inventorship on the part of Humphreys or the K-W Ignition Corp. was presented. The patentee testified briefly as to the development of the invention, and in doing so quite naturally made no distinction between the experimental fans which he himself had made before his contact with the K-W Ignition Corp. and the later ones made by that corporation for Samuels' company.

Conclusion

The Circuit Court of Appeals for the Second Circuit has in several of its recent opinions expressed itself as mindful of the fact that this Court has set a higher standard of invention than formerly required.

Picard v. United Aircraft Corporation, 128 F. (2d) 632, 636.

The invention of the patent in suit has been held to conform with that higher standard, and the decision of the Court of Appeals of the Second Circuit in sustaining the patent for the third time as valid and infringed presents no conflict with any decision of this Court.

Respectfully submitted,

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